

B. REMARKS

The Examiner is thanked for the performance of a thorough search. By this amendment, Claims 1-6, 14-24, 32-38, and 41-42 have been canceled, and Claims 43-48 have been added. Support for new Claims 43-48 is found in the present application at pages 12 and 15, for example. Hence, Claims 7-13, 25-31, 39-40, and 43-48 are pending in this application. All issues originally raised in the Office Action mailed August 11, 2004 are addressed herein.

REJECTION OF CLAIMS 1-18 UNDER 35 U.S.C. § 103(a)

Claims 1-18 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Ebner et al.*, U.S. Patent Application No. 5,384,620, in view of *Daughton et al.*, U.S. Patent Application No. 4,475,806. Claims 1-6 and 14-18 have been canceled, thereby obviating the rejections of those claims. It is respectfully submitted that Claims 7-13 are patentable over *Ebner* and *Daughton* for at least the reasons provided hereinafter.

CLAIM 7

Among other features, Claim 7 recites, “displaying a user interface that identifies a set of one or more **media types** that are currently available to a printing device for printing pages of the electronic document.” By way of example only, as indicated in the specification of the present application, media types may include types such as are indicated in media type box 318 (e.g., “thin,” “thick,” “letterhead,” “prepunched,” “recycle,” “transparency,” “light red,” etc. This example is provided only to aid the Examiner’s understanding; the provision of this example should not be construed as an

argument that Claim 7 recites each of these specific media types.) Because **media types** that are currently available are displayed, a user is spared from needing to know or discover which paper trays contain specific media types.

This may be contrasted to a hypothetical method in which only currently available **paper trays**, and not **media types**, are displayed. Even employing such a hypothetical method, a user who wished to print information on media of a particular media type would still need to find out which of the currently available paper trays contained media of the particular media type.

The Office Action concedes that *Ebner* fails to teach or suggest the feature of Claim 7 recited above. The Office Action relies on col. 3, lines 16-19 of *Daughton* to disclose, allegedly, this feature. This passage of *Daughton* indicates that a liquid crystal element (the alleged display) can indicate to a user that a **paper tray** needs attention. This may happen in response to a sensor in that paper tray sensing a lack of paper in the paper tray (col. 3, lines 7-10). However, this passage does not teach or suggest anything about detecting which **media types** are currently available or displaying currently available **media types**. Indicating that a particular paper tray is empty does not convey information about any particular media type being available or unavailable.

Even if *Ebner* and *Daughton* were combined, the combination still would not teach or suggest, “displaying a user interface that identifies a set of one or more **media types** that are currently available to a printing device for printing pages of the electronic document.” Although *Ebner* discusses different paper types (col. 5, lines 35-45), the sensors disclosed by *Daughton* are not capable of detecting what type of paper or other media is contained in a particular tray. *Daughton*’s liquid crystal element does not

display currently available **media types**. As a result, Claim 7 is patentable over *Ebner* and *Daughton*, even if the teachings of *Ebner* and *Daughton* are combined.

CLAIM 12

Among other features, Claim 12 recites, “determining that a first **media type** and a second **media type** are currently available for use at a printing device.” As is discussed above relative to Claim 7, neither *Ebner* nor *Daughton* teaches or suggests detecting or otherwise determining currently available **media types**. As a result, Claim 12 is patentable over *Ebner* and *Daughton*, even if the teachings of *Ebner* and *Daughton* are combined.

REMAINING DEPENDENT CLAIMS

The remaining dependent claims not discussed above all depend directly or indirectly from either Claim 7, 12, or a claim that recites a computer-readable medium or system analogue of the method recited in Claim 7 or 12. It is therefore respectfully submitted that the remaining dependent claims are patentable over *Ebner* and *Daughton* for at least the reasons set forth herein with respect to the independent claim on which they depend. The remaining dependent claims also recite additional features that independently render them patentable over *Ebner* and *Daughton*.

CONCLUSORY REMARKS REGARDING CLAIMS 25-31 AND 39-40

In view of the foregoing, it is respectfully submitted that Claims 25-31 and 39-40 are also patentable over *Ebner* and *Daughton*. Accordingly, reconsideration and withdrawal of the rejection of Claims 25-31 and 39-40 is respectfully requested. Additionally, because Claims 25-31 and 39-40 have not yet been cancelled, Applicants

note that, at least for the reasons stated above with respect to Claims 7-13, Claims 25-31 and 39-40 are also patentable over *Ebner* and *Daughton*.

FINAL RESTRICTION REQUIREMENT

Applicants note that the Examiner has made the requirement for restriction in this case final. However, Applicants maintain that the requirement for restriction is improper in this case. Therefore, Applicants have filed a Petition Under 37 CFR § 1.144 to request that the Honorable Commissioner for Patents review the final requirement for restriction that has been entered in this case.

CONCLUSION

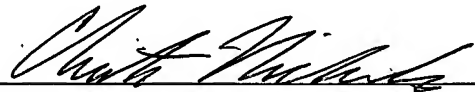
It is respectfully submitted that all of the pending claims are in condition for allowance. Therefore, the issuance of a notice of allowance is respectfully requested. If there are any additional charges, please charge them to Deposit Account No. 50-1302.

The Examiner is invited to contact the undersigned by telephone if the Examiner believes that such contact would be helpful in furthering the prosecution of this application.

Respectfully submitted,

HICKMAN PALERMO TRUONG & BECKER LLP

Date: November 9, 2004


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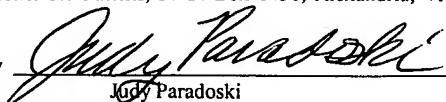
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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: **Mail Stop Non-Fee Amendment**, Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450.

On November 9, 2004

By


Judy Paradoski